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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,576	02/20/2002	Ryo Sakai	0277-0002	5007
7590	04/15/2004		EXAMINER	
Toni- Junell Herbert Reed Smith LLP 1301 K Street, N.W. Suite 1100 -East Tower Washington, DC 20005			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/018,576	SAKAI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Hoa V. Le	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 March 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 11-20, 22-27 and 29-34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-9, 11-20, 22-27 and 29-34 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

This is in response to Papers filed 29 March 2004.

- A. The record shows that the claims inventions are from the multiple Japanese priority applications.
- B. Claims 30-34 are added. Claims 10, 21 and 28 are canceled.
- C. The record shows that the fee of 29 claims have been paid only. A proper fee for the additional claims should have been timely made on 29 March 2004. A proper payment is requested and required in order for any further request to be considered.
- D. A telephone call is made to Mr. Mark R. Shanks on 14 April 2004 to request an oral restriction. However, Mr. Shanks requests a written Office action since his clients are overseas.
- E. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. The groups of claims (1-6), (7-8), (14), (15) and dependent claims 31-34 with independent 1 being broadest (are not considered to be patentably different or distinct. Therefore, no restriction is made. Accordingly, no separate consideration or search will be made. The broadest claim 1 will be firstly and independently considered and searched. Others are integrally considered and searched as set up. Should applicants show or urge otherwise in the next response to this Office

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action in order for it to be considered timely. A restriction will be made for the record as shown or urged), drawn to a novel of the same or single metal oxide powder type to be solely used in a positive electrode of a conventional or known secondary battery, classified in class 429, main subclass 209.

- II. Claims 9, 11-13 and 30 with independent claim 9 being broadest, drawn to a method of making a novel powder type to be solely used in a positive electrode of a conventional or known battery, classified in class 252, main subclass 182.1
- III. Claims 16-19 with independent claim 16 being broadest, drawn to a novel of a reclaiming material in the form of a powder particles, classified in class 75, main subclass 255.
- IV. The groups of claims (20, 22-26) and (27, 29) with independent claim 20 being broadest (are not considered to be patentably different or distinct. Therefore, no restriction is made. Accordingly, no separate consideration or search will be made. The broadest claim 20 will be firstly and independently considered and searched. Others are integrally considered and searched as set up. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as shown or urged), drawn to a method of recovering a waste material and making it into powder particles form, classified in class 29, main subclass 403.1

Inventions of Group I and Group III are all related to the material but are patentably different and distinct each from the other because they have acquired the separate status and searches in the art and can be supported the separate patents as

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divided by applicants and there is no evidence on the record that they are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one invention would be sufficient against all of the above inventions. Therefore, separate consideration of search is required. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed

Inventions of Group II and Group IV are all related to the method but are patentably different and distinct each from the other because they have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and there is no evidence on the record that they are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one invention would be sufficient against all of the above inventions. Therefore, separate consideration of search is required. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the powder particles as claimed can be made by another and materially different process than separating and removing simultaneously as claimed. Applicant should show or

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provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions Group III and Group IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the powder particles as claimed can be made by another and materially different process than separating and removing simultaneously as claimed. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in In re Ochiai, 37 USPQ2d 1127 or In re Brouwer, 37 USPQ2d 1663 and MPEP 821.04.

G. Other issues have not been considered until a proper election is made and resolved.

H. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
14 April 2004

HOA VAN LE  
PRIMARY EXAMINER  
*Hoa Van Le*